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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,590	04/08/2004	Paul Albert Sagel	9031R	8118

27752 7590 10/26/2009
THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI, OH 45202

EXAMINER

ROBERTS, LEZAH

ART UNIT	PAPER NUMBER
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1612

MAIL DATE	DELIVERY MODE
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10/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/820,590	Applicant(s) SAGEL ET AL.	
	Examiner LEZAH W. ROBERTS	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-12 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-12 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed June 26, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims

Claim Rejections - 35 USC § 112 – Indefiniteness (Previous Rejection)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 18 and 22 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 22 recites the limitation "less than about." The term "less than" delineates only numerical values more than the recited value where the term "about" may be less than or more than the recited value.

Applicant's Arguments

Applicants disagree with the Office Action's assertion that there is a conflict of terms when using the combination of less than and about. The phrase "less than" modifies the term "about 1 mm." Thus, even if the use of "about" before 1 mm allows for a number greater than 1 mm, there is no conflict of terms. For example, if "about 1 mm" was equivalent to 1.1 mm, then the claim would read less than 1.1 mm. As can be seen from the example, there is no conflict of terms with the use of "less than" to modify the term "about 1 mm."

Examiner's Response

The term "less than" delineates only numerical values more than the recited value where the term "about" may be less than or more than the recited value. It cannot be determined the limits encompassed by "less than about". The term about may encompass 1.1 to 1.5 and thus it is not certain if "less than about" encompasses less than 1.1 or less than 1.5, making the claim indefinite.

2) Claims 17 and 18 recite the phrases "substantially coextensive" and "substantially water impermeable" respectively.

Applicant's Arguments

With regard to the use of the term "substantially," MPEP 2173.05(b) discusses the use of the term substantially and gives two examples of where substantially was found to be definite by the Federal Circuit. Applicants submit that similar to "substantially equal" which the Federal Circuit found to be definite, one of ordinary skill

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in the art would know what was meant by "substantially coextensive" (claim 17) and "substantially water impermeable" (claim 18) see *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819 (Fed. Cir. 1988).

Examiner's Response

The term "substantially" has not been defined by the claims or the instant specification and thus it cannot be determined what variation is encompassed by the term "substantially". It is difficult to ascertain whether this would include backing layers that were slightly permeable. In the case of "substantially coextensive", the limits are not defined therefore it is difficult to ascertain if "substantially coextensive" includes more than 7/8 of the whitening composition is coextensive with the backing or 5/8 of the whitening composition is coextensive with the backing. The lack of definition of the term "substantially" makes it indefinite because the limits or parameters of the term are not defined.

Claim Rejections - 35 USC § 103 – Obviousness (Previous Rejection)

Claims 9-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Godbey et al (US 2002/0187181) in view of Chang et al. (US 2003/0194382) and Sagel et al. (US 5,891,453) in further view of Xu et al. (US 2002/0187111). The rejection is maintained and further applied to claims 1-3, 5-8, 11, 12 and 17-26. Claim 9 is cancelled.

Applicant's Arguments

Applicants argue that the teachings of Godbey and Xu as it relates to the molecular weight of polymers in the adhesive layer are adverse, not complimentary as the Office Action suggests. Godbey use lower molecular weight polymers in its adhesive layer (less than 100,000 Daltons) to have a good balance of cohesive strength and water solubility. Looking to this statement, one would believe a good balance of cohesive strength and water solubility in Godbey would require a polymer with a molecular weight between about 10,000 and 100,000 Daltons. On the other hand, Xu water hydratable polyethylene oxide homopolymers or mixtures of ethylene oxide polymers of varying molecular weight ranging from about 10,000 Daltons and up to about 10,000,000 Daltons. Godbey teaches away from the use of polymers in its adhesive layer with a molecular weight greater than 100,000 Daltons as it implies that a polymer must be within that range in order to give the desired balance of cohesive strength and water-solubility.

Examiner's Response

The Examiner submits that the Godbey does teach lower molecular weights for the adhesive composition. This does not limit the polymers of the carrier layer. Godbey discloses that polyoxyalkylenes may also be used in the carrier layer and gives no limit as to the molecular weight of these polymers. Xu discloses that the molecular weight of polyethylene oxide polymers controls the release of the whitening agent and the molecular weight of the polymers varies from 100,000 to 1,500,000. Thus, when these

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polymers are used in conjunction with the whitening agent, it would take no more than the relative skill of one of ordinary skill in the art to use a polymer of a molecular weight or combination of molecular weights to yield the desired rate of release. Further, as previously asserted in the previous office action, the motivation of combining the teachings is not only based on the cohesive strength provided by the polymer but also the release of the whitening agent. Thus, when using polyethylene oxide in the carrier comprising a whitening agent, one of ordinary skill in the art would look to Xu to determine a suitable polyoxyalkylene polymer and molecular weight suitable for use when making devices comprising a whitening agent and would ones that would provide the desired rate of release for the whitening agent.

In regard to claim 24, the whitening compositions are applied to the strip, encompassing the limitation of the whitening composition being coextensive with the backing layer. In regard to claim 25, Sagel discloses the backings may be made of woven or non woven materials encompassing partially water permeable. In regard to new claim 26, Godbey discloses the devices are 75 micrometers thick and Sagel discloses the strips are less than 1 mm thick, meeting the claimed limitation of "a thickness less than 1 mm.

Claims 1-3, 5-8, 10-12 and 17-26 are rejected.

No claims allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LEZAH W. ROBERTS** whose telephone number is (571)272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lezah W Roberts/
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612